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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Charles A. Eldering

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TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME  
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EXAMINER

HOYE, MICHAEL W

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/824,434	Applicant(s) ELDERING ET AL.	
	Examiner Michael W. Hoye	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicants' arguments filed on January 30, 2006 have been fully considered but they are not persuasive.

Regarding independent claims 25, 30 and 35, the Applicants argue on page 2 that, "although Picco collects data regarding what programming was selected on a set-top box, Picco's system is not aware of, and therefore does not examine or otherwise collect data from, the state of the presentation device (e.g., the television set, display panel or monitor) that actually presents the video image to the viewer." On page 3 the Applicants argue that, "Applicants' invention determines, for example, whether the television or video monitor was powered on at the time of the advertisement." At the bottom of page 3, the Applicants argue that, "Picco does not disclose that the state of the presentation device is monitored."

In response, the Examiner respectfully disagrees with the Applicants because Picco clearly discloses in col. 7, lines 6-24 (specifically see lines 12-24 as underlined below):

...To determine which local content is going to be combined with the live programming data feeds 106, the uplink facility may include a scheduler 148, an agent 150, and a statistical collector system 152. The scheduler may determine which local content is going to be combined by the combiner 140 with the live feeds based on a variety of information. For example, data about the local content being **watched** at a particular household 114 may be periodically communicated to the collect and decimate system 152 in the uplink facility over a communications link 154, such as a telephone line. The data from the household may include **viewing time information** as well as **the actual television programs being viewed**. The statistical collector system may collect all of the data from every household that uses the satellite-based system and then generates statistics about the data, such as the number of

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users that have viewed a particular advertisement or the number of users that viewed a particular type of advertisement. The statistics generated are fed into the agent 150.

Picco also discloses that, “the set-top box may accumulate data about when the user saw which programs and how many times the user watched a particular program” (see col. 11, lines 9-13), and in col. 12, lines 24-33, Picco specifically teaches that video streams, including the inserted local content...are output to the television so that they may be viewed by the user. Therefore, in light of the sections noted above, Picco clearly discloses the claimed, “monitoring the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers”, as met by the agent 150 and statistical collector system 152 monitoring the communications network (communications link 154) to determine...whether the selected unscheduled advertisements are presented to each of the one or more subscribers, based on users (particular household(s) 114) watching or viewing a particular advertisement, where the presentation device or television must be turned on in order for the user(s) to view or watch the advertisement, and the data about the local content (unscheduled advertisements) being watched at a particular household 114 is collected and periodically communicated to the collect and decimate system 152 in the uplink facility as described in the sections of Picco as stated above.

In response to Applicants’ argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., determining whether the television or video monitor was powered on at the time of the advertisement) are not recited in the rejected claims. Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicants also argue on the bottom of page 3 that:

Applicants respectfully, but strenuously, disagree with the Examiner's statement that "It is *inherent* that data about local content being watched at a particular household *is based on the state of the presentation device*." Applicants respectfully submit that the Examiner is incorrect in the example provided at page 2 of the Office Action, wherein the Examiner argues, "if the state of the presentation device is non-operational, data is not going to be collected." On the contrary, it is quite possible that a set-top box could be on while its corresponding presentation device is off...

In response, the Examiner still respectfully disagrees because while the presentation device or television is "on", the set-top box gathers data about the local content being watched at a particular household 114, which may include viewing time information as well as the actual television programs being viewed, and the data is periodically communicated to the uplink facility, which monitors the communications network and generates statistics based on the data received from the household(s). If the presentation device (i.e. television) is not operating in the "on" state, and is in the "off" state, unscheduled advertisements cannot be viewed by a user, and more specifically, data about local content being watched is obviously not collected while the presentation device is in the "off" state by the set-top box. Moreover, data collected by the set-top box, such as viewing statistics, may be transmitted to the uplink facility at the request of the scheduler 148 (see col. 7, lines 33-48) regardless of whether the state of the presentation device is on or off. Therefore, the state of the set-top box is not what the Examiner equated to the claimed "state of the presentation device" based on the remarks made above and the relevant cited portions of Picco.

Additionally, the Applicants argue on page 4 that, "Picco does not disclose "monitoring the communications network"." Finally, the Applicants argue that, "Picco does not disclose that the system operator can actively request view profile information from a set-top box."

In response, the Examiner respectfully disagrees with the Applicants and refers to the relevant remarks previously stated above, where Picco specifically teaches that data collected by the set-top box, such as viewing statistics (which is viewer profile information), may be transmitted to the uplink facility at the request of the scheduler 148 (see col. 7, lines 33-48). In addition to, in response to Applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the system operator can actively request view profile information from a set-top box) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims **25-39** are rejected under 35 U.S.C. 102(b) as being anticipated by Picco et al (US 6,029,045).

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Regarding claim **25**, Picco teaches a method of inserting unscheduled advertisements into a television programming stream in a communications network, the method comprising (a) selecting one or more unscheduled advertisements to be presented at a presentation device to one or more subscribers to the communications network (See Figs. 9, 10 and Col. 13 lines 36-67, Col. 14 lines 1-16); (b) storing the unscheduled advertisements at a node of the communications network (See Figs. 9, 10 and Col. 13 lines 36-67, Col. 14 lines 1-16); (c) detecting intervals in said programming stream within which advertisements may be inserted (See Figs. 9, 10 and Col. 13 lines 36-67, Col. 14 lines 1-16); (d) inserting the unscheduled advertisements into said programming stream within the detected intervals (See Figs. 9, 10 and Col. 13 lines 36-67, Col. 14 lines 1-16); and (e) monitoring the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers (Col. 6 lines 57-67, Col. 7 lines 1-32). More specifically, Picco clearly discloses in col. 7, lines 6-24 (specifically see lines 12-24 as underlined below):

...To determine which local content is going to be combined with the live programming data feeds 106, the uplink facility may include a scheduler 148, an agent 150, and a statistical collector system 152. The scheduler may determine which local content is going to be combined by the combiner 140 with the live feeds based on a variety of information. For example, data about the local content being **watched** at a particular household 114 may be periodically communicated to the collect and decimate system 152 in the uplink facility over a communications link 154, such as a telephone line. The data from the household may include **viewing time information** as well as **the actual television programs being viewed**. The statistical collector system may collect all of the data from every household that uses the satellite-based system and then generates statistics about the data, such as the number of users that have viewed a particular advertisement or the number of users that viewed a particular type of advertisement. The statistics generated are fed into the agent 150.

Picco also discloses that, “the set-top box may accumulate data about when the user saw which programs and how many times the user watched a particular program” (see col. 11, lines 9-13), and in col. 12, lines 24-33, Picco specifically teaches that video streams, including the inserted local content...are output to the television so that they may be viewed by the user. Therefore, in light of the sections noted above, Picco clearly discloses the claimed, “monitoring the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers”, as met by the agent 150 and statistical collector system 152 monitoring the communications network (communications link 154) to determine...whether the selected unscheduled advertisements are presented to each of the one or more subscribers, based on users (particular household(s) 114) watching or viewing a particular advertisement, where the presentation device or television must be turned on in order for the user(s) to view or watch the advertisement, and the data about the local content (unscheduled advertisements) being watched at a particular household 114 is collected and periodically communicated to the collect and decimate system 152 in the uplink facility as described in the sections of Picco as stated above. Furthermore, Picco teaches that while the presentation device or television is “on”, the set-top box gathers data about the local content being watched at a particular household 114, which may include viewing time information as well as the actual television programs being viewed, and the data is periodically communicated to the uplink facility, which monitors the communications network and generates statistics based on the data received from the household(s). If the presentation device (i.e. television) is not operating in the “on” state, and is in the “off” state, unscheduled advertisements cannot be viewed by a user, and more specifically, data about local content being



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watched is obviously not collected while the presentation device is in the "off" state by the set-top box. Moreover, data collected by the set-top box, such as viewing statistics (which is viewer profile information), may be transmitted to the uplink facility at the request of the scheduler 148 (see col. 7, lines 33-48) regardless of whether the state of the presentation device is on or off.

Regarding claim **26**, Picco teaches the method further comprising: (f) selecting different unscheduled advertisements to be presented to the one or more subscribers based on the monitoring in step (e) (See Figs. 9, 10 and Col. 7 lines 32-67, Col. 8 lines 23, Col. 13 lines 36-67, Col. 14 lines 1-16).

Regarding claim **27**, Picco teaches the method further comprising: (f) inserting the unscheduled advertisements into a different programming stream based on the monitoring in step (e) (See Figs. 9, 10 and Col. 7 lines 32-67, Col. 8 lines 23, Col. 13 lines 36-67, Col. 14 lines 1-16).

Regarding claim **28**, Picco teaches wherein the unscheduled advertisements are inserted into said programming stream in accordance with a pre-determined order (See Col. 8 lines 16-22, Col. 10 lines 13-18 Control signals can determine which type of advertisement (i.e. car) is shown during a particular time slot thus invoking a pre-determined order. The advertisements remain unscheduled because the advertisement of the specified type that is shown is not associated with program content).

Regarding claim **29**, Picco teaches the method further comprising: (f) reporting the results the monitoring in step (e) (See Fig. 4 Statistics Collector 152 and Col. 6 lines 57-67, Col. 7 lines 1-32).

Regarding claim **30**, Picco teaches an advertisement insertion system for inserting unscheduled advertisements into a television programming stream in a communications network, the system comprising: an advertisement selector, configured to select one or more unscheduled advertisements to be presented at a presentation device to one or more subscribers to the communications network (See Fig. 4 Scheduler 148 and Col. 7 lines 32-67, Col. 8 lines 1-6); an advertisement storage medium located at a node of the communications network, the storage medium containing the unscheduled advertisements (See Fig. 3 186 Disk and Col. 6 lines 17-4, Col. 9 lines 40-52); an insertion processor configured to detect intervals in said programming stream within which advertisements may be inserted and insert the unscheduled advertisements into said programming stream within the detected intervals (See Fig. 3 CPU 188 and Fig. 10 Step 254 and Col. 13 lines 66-67, Col. 14 lines 1-16); and a monitor processor configured to monitor the communications network to determine, based on the state of the presentation device, whether the selected unscheduled advertisements are presented to each of the one or more subscribers (See Fig. 3 CPU 188, Col. 6 lines 57-67, Col. 7 lines 1-32 Data about which advertisements have been viewed is transmitted from the STB to the statistic collector).

Regarding claim **31**, Picco teaches wherein the advertisement selector selects different unscheduled advertisements to be presented to the one or more subscribers based on an output of the monitor processor (See Col. 7 lines 33-67, Col. 8 lines 1-7).

Regarding claim **32**, Picco teaches wherein the insertion processor is configured to insert the unscheduled advertisements into a different programming stream based on an output of the monitor processor (See Col. 13 lines 66-67, Col. 14 lines 1-16).

Regarding claim **33**, Picco teaches wherein the unscheduled advertisements are inserted into said programming stream in accordance with a pre-determined order (See Col. 8 lines 16-22, Col. 10 lines 13-18 Control signals can determine which type of advertisement (i.e. car, watch, etc.) is shown during a particular time slot thus invoking a pre-determined order. The advertisements remain unscheduled because the specific advertisement of the specified type that is shown is not determined until the ahead of time).

Regarding claim **34**, Picco teaches wherein the monitor processor is configured to report the results of the monitoring (See Fig. 4 Statistics Collector 152 and Col. 6 lines 57-67, Col. 7 lines 1-32).

Regarding claims **35-39**, claims **35-39** are article of manufacture comprising a computer-readable medium holding computer-executable instructions that execute the methods of claims 25-29, respectively. Thus claims **35-39** are discussed and rejected according to claims 25-29, respectively.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is **571-272-7346**.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at **571-272-7353**.

**Any response to this action should be mailed to:**

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**Or faxed to: 571-273-8300**

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **571-272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **<http://pair-direct.uspto.gov>**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Michael W. Hoyer  
April 21, 2006

  
**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
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